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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/768,606	12/18/1996	ANDREW T. BUSEY	4068.P002X	1226

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EXAMINER

KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/768,606

Applicant(s)

BUSEY ET AL.

Examiner

Alford W. Kindred

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-48,66,67 and 69-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-48,66,67 and 69-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Appeal Brief, filed on 4/25/05.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10 and 28 are rejected under the judicially created doctrine of double patenting over claims 1 and 17 of U. S. Patent No. US# 6,785,708 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: claims 10 and 28 of the instant application recite

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establishing a chat region controlled by a browser while Claims 1 and 17 of Patent recite "establishing browser and chat region on a first display". The establishing of chat regions in browsers and displays includes the ability to process chat functions and thus, the applications claims of 10 and 28 are obvious over the Patent's claims 1 and 17

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-48, 66-67, and 69-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volano, "VolanoChat Java solution turns ordinary web sites into interactive money makers", Business Wire, pp.1-2, in view of Judson, U.S. Patent Number 5,572,619, filed 10/19/95, class 395/793, title "Web browser with dynamic display of information objects during linking", and further view of Donath et al., 1996.

With respect to independent claim 10, Volano discloses, "establishing a chat region controlled by a chat client" ("VolanoChat works with all Java-compatible browsers . . . can accommodate large numbers of simultaneous real-time interactions . . . such as browser plug-ins, Internet chat . . ."--page 1 of 2). Volano does not disclose "a browser frame controlled by a browser client . . .". Anupam discloses "a browser frame controlled by a browser client . . . with the browser region" (see fig. 1,--sheet 1 of 4. It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Anupam and Volano above, because using the steps of a browser client that is controlled by a browser frame, would have given those skilled in the art the ability to incorporate chat functions in a user's browser. Volano does not disclose "in response to a command received by a computer, establishing a browser . . .". Judson discloses "in response to a command received by a computer, establishing a browser . . ." ("client machine having a browser, wherein the information objects are downloading of a hypertext object, selectively displaying one of the stored information objects . . ."--column 10, line 53). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson "in response to a command received by a computer, establishing a browser . . ." ("client machine having a browser, wherein the information objects are downloading of a hypertext object, selectively displaying one of the stored information objects . . ."--column 10, line 53) with the teachings of Volano above, because using the steps of "in response to a command received by a computer, establishing a browser . . ." would have given those skilled in the art the tools to create a browser in the an Internet

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environment. This give users the ability to user browsers to view and manipulate information on the Internet via commands of a computer. Volano does not explicitly teach "in response to receiving chat content including a link to a web page . . . detecting selection, by a user of the display device . . . invoking the browser client . . . the link and displaying the obtained web page in the browser region". Donath et al. teaches "in response to receiving chat content including a link to a web page . . . detecting selection, by a user of the display device . . . invoking the browser client . . . the link and displaying the obtained web page in the browser region" (see pages 1-4). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Volano and Donath because using the steps of "in response to receiving chat content including a link to a web page . . . detecting selection, by a user of the display device . . . invoking the browser client . . . the link and displaying the obtained web page in the browser region" would have given those skilled in the art the tools to link web page data while also detecting and manipulating chat content in a fashion illustrated in applicant's claim language above. This give users the advantage of improving the transmission of chat content more efficiently.

With respect to dependent claim 11, Volano discloses "displaying the chat region and the browser region simultaneously on the display device; and allowing a user to concurrently perform a chat function, a browser function or both" ("simultaneous real-time interactions . . . user-group support . . ."--page 1 of 2).

With respect to dependent claim 12, Volano discloses "establishing the browser and chat regions on the display device, the command being received by the computer

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from a user or a computer network" ("optimized for novice Web users that just want to chat . . . all the Java chat applications . . ."--page 1 of 2).

With respect to dependent claim 13, Volano discloses "with a chat client resident on the computer, processing chat content using a browser server for display in the chat region; with a browser resident on the computer, processing a document or other content for concurrent display in the browser region" ("Volano markets Java solutions for multi-user environments . . . a Web-based chat solution written entirely in Java . . ."page 2 of 2).

With respect to dependent claim 14, Volano discloses "linking the chat client to the browser so that the chat client controls the content displayed in the browser region." Judson discloses "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" ("the first hypertext document . . . link that initiates downloading of the second hypertext document . . ."--column 8, line 45). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" ("the first hypertext document . . . link that initiates downloading of the second hypertext document . . ."--column 8, line 45) with the teachings of Volano above, because using the steps of "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" would have given those skilled in the art the tools to link chat data controls to the client. This gives users at the client the benefit of using browser functions when operating in the chat mode.

with respect to dependent claim 15, Volano discloses "linking the chat client to the browser through an application program interface of the browser" ("administrative features include modification of all user-interface text . . ."--page 1 of 2).

With respect to dependent claim 16, Volano discloses "in response to the chat content received by the computer, invoking the chat client through the application program interface, so that the chat content is displayed in the chat region" ("VolanoChat supports banner advertisements in its chat rooms . . ."--page 1 of 2).

With respect to dependent claim 17, Volano discloses "so that the chat content is displayed in the chat region, the chat content being of a particular MIME type" ("the first Java based chat solution . . . complete administrative control . . ."--page 1)

With respect to dependent claim 18, Volano does not disclose "so that the chat content is displayed in the chat region, the chat client including a file having a particular extension." Judson discloses "so that the chat content is displayed in the chat region, the chat client including a file having a particular extension" ("supports files in the form of documents and pages . . . protocol that provides user access to files . . ."--column 3, line 53). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson "so that the chat content is displayed in the chat region, the chat client including a file having a particular extension" ("supports files in the form of documents and pages . . . protocol that provides user access to files . . ."--column 3, line 53) with the teachings of Volano above, because using the steps of "so that the chat content is displayed in the chat region, the chat client including a file having a particular extension" would have given those skilled in the

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art the tools to recognize and display data according the extension without opening the entire file.

With respect to dependent claim 19, Volano discloses "linking the chat client to the browser through the application program interface, the application program interface being implemented as a plug-in architecture" ("chat technologies, such as browser plug-ins . . ."--page 1 of 2).

With respect to dependent claim 20, Volano discloses "an ActiveX architecture" ("Volcano server runs on any platform that supports Java, including Microsoft . . ."--page 1 of 2).

With respect to dependent claim 21, Volano discloses "displaying the chat content in the chat region" ("Java based chat solution to offer in-room advertising . . ."--page 1 of 2).

With respect to dependent claim 22, Volano discloses "displaying the browser content in the browser region" ("Browser plug-ins, Internet Relay chat . . ."--page 1 of 2).

With respect to dependent claim 23 and 66-68, Volano does not disclose "the browser content including a markup language document." Judson discloses "the browser content including a markup language document" ("HTML tag is a "comment," . . . by the browser . . . HTML elements . . ."--column 5, line 6). It would have been obvious at the time of the invention for one of ordinary skill to have combined the teachings of Judson "the browser content including a markup language document" ("HTML tag is a "comment," . . . by the browser . . . HTML elements . . ."--column 5, line 6) with the teachings of Volano above, because using the step of "the browser content

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including a markup language document” would have given those skilled in the art the tools to view markup language via a browser. This gives users the ability to view interactions with information on the Internet.

With respect to claim 24, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 3 and is similarly rejected.

With respect to dependent claim 25, Volano does not disclose “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region.” Judson discloses “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region” (the browser may be suitably programmed to queue the mini web page . . .”--column 6, line 42). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region” (the browser may be suitably programmed to queue the mini web page . . .”--column 6, line 42) with the teachings of Volano above, because using the steps of “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region” would have given those skilled in the art the ability to send and retrieve chat functions from embedded web pages and browsers. This allows users to communicate faster in chat rooms and the like.

With respect to claims 26 and 27, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 3 and are similarly rejected.

With respect to independent claim 28 and dependent claims 29-47, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 10 and dependent claims 11-27. In independent claim 28 and dependent claims 29-47, Applicant claims a system which contains means corresponding to the steps of the method of independent claim 10 and dependent claims 11-27.

As per claim 67, this claims is rejected on grounds corresponding to the arguments given above for rejected claim 10 and is similarly rejected.

As per claims 69-70, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10 and 28, above and are similarly rejected.

As per claims 71-83, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10-27 and are similarly rejected.

As per claims 84-97, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10-22 and 28-32 and are similarly rejected including the following:

--Volano teaches "{a first chat session . . . a first target . . . second target . . ."
(see pages 1-2).

Response to Arguments

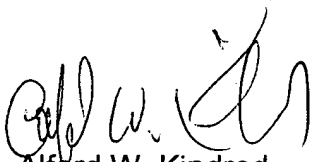
5. Applicant's arguments with respect to claims 10-48, 66-67, and 69-97 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 571-272-4037. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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